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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/633,168	08/01/2003	David Shen	12729/11	4598
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EXAMINER CHAMPAGNE, DONALD				
ART UNIT 3688		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/633,168

Applicant(s)

SHEN ET AL.

Examiner

Donald L. Champagne

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Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 February 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 13 February 2009 has been entered.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1 and 3-37 are rejected under 35 U.S.C. 101 because the claimed invention is not directed to statutory subject matter. Based on Supreme Court precedent, to be patent eligible under 35 U.S.C. 101 a method/process claim must (1) be tied to a particular machine or apparatus or (2) transform a particular article into a different state or thing (see at least *Gottschalk v. Benson*, 409 U.S. 70 (1972); *Diamond v. Diehr*, 450 U.S. 192 (1981); *Parker v. Flook*, 437 U.S. 589 n.9 (1978); and *Cochrane v. Deener*, 94 U.S. 780, 788 (1876)). Furthermore, the Supreme Court held that the use of a specific machine or transformation of an article must impose meaningful limits on the claim's scope to impart patentability (*Benson*, 409 U.S. 71-72). The involvement of the machine or transformation must not merely be insignificant extra-solution activity (*Flook*, 437 U.S. 590). Also see *In re Bilski*, No. 2007-1130, __F.3d__, 2008 WL4757.
4. The claims are tied to a machine or apparatus, a "computer readable medium", but this is at best a nominal recitation that does not qualify as a *specific* machine or apparatus and does not impose a *meaningful* limitation. The claimed limitation appears only in a preamble, which is not given patentable weight. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but,

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instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1 and 3-37 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In each independent claim 1 and 20, "calculating performance scores" is not enabled because a person skilled in the art would not be able to practice the invention without undue experimentation (MPEP § 2164-2164.08(c)). "Practice" in the instant context means being able to achieve a repeatable result (a so-called "concrete" result, MPEP § 2106.IV.C.2(2)(c)). The specification does not disclose any objective means or algorithm by which one of ordinary skill in the art could repeatably calculate performance scores.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1 and 3-37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In each independent claim 1 and 20, "calculating performance scores" is indefinite because the applicant has failed to disclose any objective means or algorithm by which to identify said plurality of products (*Aristocrat Techs. Austl. Pty Ltd. v Inter Game Tech.*, 521 F.3d 1328, 1333 (Fed. Cir. 2008)).
9. Claim 37 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 37 contains an improper Markush group (MPEP § 2173.05(h)(1)).

Applicability of 35 USC 112, 6th Paragraph

10. It appears the applicant is attempting to invoke 35 U.S.C. 112, 6th paragraph in claims 20-36 by using "means-plus-function" language, such as "means for collecting" (claim 20 line 3). Also see p. 11, top para. of the arguments filed 13 February 2009. In order to successfully invoke the sixth paragraph, a three-prong test must be met (MPEP § 2181.I): (1) the claim limitations must use the phrase "means for" or "step for"; (2) the "means for" or "step for" must be modified by functional language; and (3) the phrase "means for" or "step for" must not be modified by sufficient structure, material, or acts for achieving the specified function. The above claims pass the three prong test, so 35 U.S.C 112, 6th paragraph has been successfully invoked. The Examiner will consider the means to perform the claimed functions as the means disclosed, specifically in para. [0096] *et seq.* of the published application (US 20040204983A1), and equivalents thereof.

Claim Rejections - 35 USC § 102 and 35 USC § 103

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21 (2) of such treaty in the English language.

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 1, 3-9, 11, 14, 16-28, 30 and 34-37 are rejected under 35 U.S.C. 102(e) as being anticipated by Srinivasan et al. (US 20020042738A1, hereafter "Srinivasan").

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14. Srinivasan teaches (independent claims 1 and 20) a computer-readable medium (*database 275*, Fig. 2 and para. [0067]) containing an executable method of determining, through the use of a processor, the performance of an ad, comprising:

collecting a plurality of input data points (*different formats of the same advertisement*, para. [0029], and *experiment parameter values*, para. [0059]);

collecting a plurality of outcome data points (*statistics on the audience response*, para. [0029], *output from the Server Module 260*, para. [0059]); and

calculating performance scores (*optimal values of key market decision variables*, para. [0025], *statistics on the audience response*, para. [0029], and *the buy-rate*, para [0086]) based upon the input data points and outcome data points;

wherein the input data points include data points about an advertisement description (*different formats of the same advertisement*, para. [0029]) and wherein the outcome data points include data points about user opinions to identify a judgment of the user (*statistics on the audience response*, para. [0029]).

15. Srinivasan also teaches at the citations given above claims 6-8, 9 (inherently, to gather *statistics on the audience response*), 14, 16, 18, 24-26 and 28.
16. Srinivasan also teaches: claims 3, 4, 21 and 22 (para. [0058], where *an employee* reads on "an Evaluator"); claims 5 and 23 (para. [0087]); claims 11, 17, 19, 27, 30 and 34-36 (para. [0049]); and claim 37 (para. [0106]).
17. Claims 10, 12, 13, 15, 29 and 31-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Srinivasan et al. (US 20020042738A1, hereafter "Srinivasan"). Srinivasan does not teach (claims 10 and 29) a pop-up window and (claims 12, 13, 15 and 31-33) soliciting comments that are analyzed for key words. However, the reference does teach determining the *audience response* (para. [0029]) and that *surveys* of the audience are common (para. [0022]). Official notice is taken (MPEP § 2144.03) that pop-up windows were a common means of presenting surveys at the time of the instant invention. Asking for comments in the surveys was also common, and key-word analysis would have been an obvious mechanical efficiency in analyzing these comments.
18. Traverse of the taking of Official Notice - On pp. 13-14 of the arguments filed 26 September 2008, applicants have traversed the examiner's taking of official notice. However, applicant

has not provided adequate information or argument so that *on its face* it creates a reasonable doubt regarding the circumstances justifying the official notice (MPEP § 2144.03). An effective traverse must be based on compelling argument or alleged evidence, not mere denial. Applicants argues that they are "not aware" that these limitations are common. This is not compelling. Applicant could, for example, have gone on record that they had searched for one or more of the limitations without finding it. The examiner would then have been compelled to produce a references in order to maintain the tasking of official notice. But applicant submitted no such evidence. Therefore, the presentation of a reference to substantiate the official notice is not deemed necessary. The examiner's taking of official notice is maintained.

Response to Arguments

19. Applicant's arguments filed with an amendment on 13 February 2009 have been considered but they are not persuasive. The rejection under 35 USC 101 has been revised, as explained in para. 2-4 above. It is noted that the examiner suggested the instant amendment of claims 20-36 (para. 23 of the Office action mailed 5 January 2009) in such a way as the enable the present rejection of these claims under 35 USC 101. The examiner regrets giving what was in effect advice that was at least incomplete, but the instant rejection is necessary under the law as explained in para. 2-4 above.
20. Concerning the rejections under 35 USC 112 (para. 5-8 above), applicant argues (p. 11, last two para.) that "calculating performance scores" is enabled and not indefinite because of formulas disclosed in para. [0051]-[0086] of the published application (US 20040204983A1). The examiner disagrees for the reasons given in para. 21 and 22 of the last Office action. In particular,

"22. The instant application contains no algorithm or other clear definition for its calculation means. The spec. does give formulas which might qualify as an algorithm (e.g., "Expression 12" at para. [0086] of the published application), but it is disclosed that these formulas "may" be the means for calculating a score, which does not meet the requirements for a "clear definition". However, this or other parts of the spec. might qualify as a meaningful limit if claimed expressly. The essential requirement is that one of ordinary skill in the art must be able to take certain inputs

and be able to produce certain outputs without undue experimentation." (Para. 22 of the Office action mailed 5 January 2009. Emphasis added.)

21. Applicant's argument concerning the alleged limitations of Aristocrat (p. 12, top two para.) is noted.
22. Applicant's argument against the prior art rejection (p. 12 *et seq.*) is based on logical errors. On the one hand, applicant claims "calculating performance scores". One of ordinary skill in the art would understand that "calculating" requires numbers, which are decidedly "objective data". On the other hand, applicant argues (p. 13, 2nd para.) that Srinivasan gathers only "objective data such as click-through rates or buy-rates" and therefore does not include "gathering data on user opinions or user experience". Applicant's argument confuses an abstraction with its measure. "User opinions" and "user experience" are abstractions from which nothing can be calculated directly. Neither "user opinions" nor "user experience" is disclosed to be an argument in applicant's formulas, because neither can be. "User opinions" and "user experience" are abstractions which must first be measured before they can be used as a basis for calculation. One of ordinary skill in the art would know that the "click-through rates" and "buy-rates" taught by Srinivasan (collectively called *statistics on the audience response*) are measures of user opinion and user experience.

Conclusion

23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached after Noon on Monday and Wednesday through Friday. The examiner can also be contacted by e-mail at donald.champagne@uspto.gov, and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717.
24. The examiner's supervisor, James W. Myhre, can be reached on 571-272-6722. The fax phone number for all *formal* fax communications is 571-273-8300.
25. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information

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about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

26. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, www.uspto.gov. At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

10 May 2009

/Donald L. Champagne/
Primary Examiner, Art Unit 3688